

## **REMARKS**

### **Formal Matters**

Claims 1 and 5 are the claims currently pending in the Application. Claims 2-4 and 6-8 are withdrawn.

### **Rejection of Claims 1 and 5 Under 35 U.S.C. §103**

Claims 1 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chaganti et al., U.S. Patent No. 6,845,448 (hereinafter “Chaganti”) and further in view of Katsikas, U.S. Patent 6,868,498. This rejection should be withdrawn based on the comments and remarks herein.

Chaganti discloses a method and system for gathering and storing personal information on a server computer, and releasing this information to authorized requesters. (column 2, lines 18-22). The invention includes the steps of establishing an account, assigning an identifier, and assigning at least one of a plurality of security levels to each information object, and receiving a request message comprising at least the user identifier (column 2, lines 28-40). The Examiner states that Chaganti fails to disclose “a personal information storer configured to store identifying information for a recipient of an electronic mail sent by the user” as recited in claim 1. However, the Examiner states that Katsikas teaches such a personal information storer, since Katsikas teaches an authorized senders list (ASL) to accept only email from senders on the ASL list (column 4, lines 51-53).

The Examiner further states that it would have been obvious to one of ordinary skill in the art to incorporate Katsikas’ teaching of the personal information storer in the teachings of Chaganti for the purpose of protecting the personal information of users by

controlling the access of unknown requesters/recipients to the user's personal information.

Applicant respectfully objects to this hypothetical combination of Chaganti and Katsikas because the Examiner provides no actual evidence which would motive or suggest to one skilled in the art to add the ASL of Katsikas to the invention of Chaganti.

It has been held that “[t]o prevent the use of hindsight based on the invention to defeat patentability of the invention ... the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In the present application, an inventive solution to the problem of providing personal information data only to a person with whom a user has communicated by electronic mail is disclosed and claimed (see page 3, lines 15-17). A skilled artisan presented with this problem might first look to Chaganti for a possible solution. However, while Chaganti discloses an “invention [which] is directed toward a method and system for gathering, storing personal information on a server computer and releasing such information to authorized requesters” (column 2, lines 18-21), the Examiner states that Chaganti fails to teach the personal information storer configured to store identifying information for a recipient of an electronic mail sent by the user. With the teaching of Chaganti, the skilled artisan would NOT look to Katsikas for a solution to the problem of the present invention because “the fundamental principle of the present invention [of Katsikas] is to reject all email unless listed on an inclusion list as authorized” (col. 3, lines 24-26). Thus Katsikas’ does not address the problem of the present invention of providing personal information data only to specific persons, that is, persons with whom a user has communicated by electronic mail. Katsikas does not disclose providing any

information to any specific users, but instead teaches preventing the dissemination of unwanted e-mail messages by maintaining an ASL (Authorized Sender List) which captures sender and recipient email addresses from email sent by the user (col. 4, lines 43-46). Thus a skilled artisan would not look to a system for preventing or blocking transmission of email messages to solve the problem of the present invention which is to provide information only to a particular person.

The Federal Circuit has stated that the PTO must explain all material facts relating to a motivation to combine, and that “assumptions about common sense cannot *substitute* for evidence thereof”. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1366-7 (Fed. Cir. 2006) (emphasis in original). As discussed above, the Examiner’s assumption that one of ordinary skill in the art at the time the invention was made would have incorporated Katsikas’ teachings in the teachings of Chaganti is not supported with evidence because, *inter alia*, combining Chaganti with Katsikas to solve the problem of applicant’s invention is inapposite. Thus the Examiner has not established a prima facie case of obviousness.

Therefore, Applicant respectfully submits that independent claims 1 and 5 are patentably distinguished over any art of record in the application, and requests that these claims be allowed.

### **Conclusion**

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable and respectfully requests that the Examiner reconsider the rejections and allow the Application. Should the Examiner have any questions regarding this

Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Katherine R. Vieyra", written in a cursive style.

Katherine R. Vieyra  
Registration No. 47,155

SCULLY, SCOTT, MURPHY & PRESSER, P.C.  
400 Garden City Plaza, Suite 300  
Garden City, New York 11530  
(516) 742-4343

KRV/kd